

REMARKS

I. Introduction

In response to the Office Action dated April 15, 2008, claims 1, 23 and 45 have been amended. Claims 1, 4-23, 26-45 and 48-66 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

II. Claim Amendments

Applicant's attorney has made amendments to claims 1, 23 and 45 as indicated above. These amendments were made solely for the purpose of clarifying the language of claims 1, 23 and 45, and were not required for patentability or to distinguish the claims over the prior art.

III. Statutory Subject Matter Rejections

In paragraphs (6)-(7) of the Office Action, claims 23, 26-45, and 48-66 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Applicant's attorney has amended the claims to overcome the rejections, in the interest of expediting prosecution.

Should issues still remain in this regard, Applicants' attorney requests that the Examiner indicate how the rejection can be overcome, in accordance with the directives of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (Guidelines)

II. See also M.P.E.P. §2106. Specifically, should it be necessary, the Applicants' attorney requests that the Examiner identify features of the invention that would render the claimed subject matter statutory if recited in the claim. See Guidelines IV.B. See also M.P.E.P. §2106.

IV. Prior Art Rejections

In paragraphs (8)-(9) of the Office Action, claims 1, 4-16, 19-23, 26-38, 41-45, 48-60, and 63-66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Padwick et al., "Special Edition Using Microsoft Outlook 2000," (Padwick-Outlook 2000) in view of Chen et al., U.S. Patent No. 6,009,442 (Chen). In paragraph (10) of the Office Action, claims 17-18, 39-40, and 61-62 were rejected under 35 U.S.C. §103(a) as being unpatentable over Padwick- Outlook 2000 in view of Chen, and further in view of Larson et al., U.S. Patent No. 5,825,854 (Larson).

Applicant's attorney notes that the rejections based on Padwick-Outlook 2000 and Chen were last presented in the Office Action dated November 29, 2005, and were previously overcome

in the response filed by Applicants' attorney dated February 27, 2006, as acknowledged by the rejections' absence in the Office Action dated April 25, 2006. Nonetheless, the Office Action reintroduces the rejections in this current Office Action.

Consequently, Applicant's attorney again traverses these rejections. Applicant's attorney submits that the claimed invention distinguishes over the references. Specifically, the combination of references does not teach or suggest making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by an electronic messaging application when the electronic message is authored by its originator or received by its recipient.

For example, the Office Action acknowledges that Padwick-Outlook 2000 fails to disclose making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader. Nonetheless, the Office Action asserts that Chen teaches these limitations. Further, the Office Action asserts that Chen teaches altering the electronic message when it is authored or received.

However, Chen explicitly states that emails or other documents must be imported into its document management system. See, col. 3, 37-59 of Chen. Moreover, Chen's document management system is not an electronic messaging application. Consequently, Chen does not make the alterations when the electronic message is authored by its originator or received by its recipient. Instead, Chen teaches functions that are performed only when the email has been imported into the document management system.

Larson fails to overcome the deficiencies of Padwick-Outlook 2000 and Chen. Recall that Larson was cited only against dependent claims 17-18, 39-40, and 61-62, and only for teaching a telephone access system that inserts an audio file at a highlighted term of an electronic message.

Thus, even when combined, the references do not teach or suggest all the limitations of Applicants claims. Moreover, the various elements of Applicant's claimed invention together provide operational advantages over the references. In addition, Applicant's invention solves problems not recognized by the references.

As a result, Applicant's attorney submits that independent claims 1, 23 and 45 are allowable over Padwick-Outlook 2000 and Chen. Further, dependent claims 4-22, 26-44 and 48-66 are submitted to be allowable over Padwick-Outlook 2000, Chen and/or Larson in the same manner, because they are dependent on independent claims 1, 23, and 45, respectively, and thus contain all

the limitations of the independent claims. In addition, dependent claims 4-22, 26-44 and 48-66 recite additional novel elements not shown by Padwick-Outlook 2000, Chen and/or Larson.

V. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

It is believed that no fees are due at this time. Nonetheless, should any charges be deemed necessary, please charge any such fees, or credit any overpayments, to Deposit Account No. 50-0494 of Gates & Cooper LLP.

Respectfully submitted,

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